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Attorney Docket No. 15966-534C CIP1
(CURA-34C CIP1)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Shimkets and Leach
ASSIGNEE : CURAGEN CORPORATION
SERIAL NUMBER : 09/472,688
FILING DATE : December 27, 1999

EXAMINER: M. Moran
ART UNIT: 1631

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FOR : NUCLEIC ACIDS CONTAINING SINGLE NUCLEOTIDE
POLYMORPHISMS AND METHODS OF USE THEREOF

June 27, 2001
Boston, Massachusetts

Assistant Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL

Transmitted herewith for filing in the above-identified application are:

- ☒ a Response to Restriction Requirement (4 pages);
- ☒ a Petition for Extension of Time (1 page, in duplicate);
- ☒ one check (#9342) in the amount of \$445.00 in payment of the extension fee; and
- ☒ Postcard.

If the enclosed papers are considered incomplete, the Mail Room is respectfully requested to contact the undersigned collect at telephone (617) 542-6000. Please charge any additional fees that may be due, or credit any overpayment, to Deposit Account No. 50-0311, Reference No.15966-534C CIP1 (CURA-34C CIP1). A duplicate copy of this Transmittal is enclosed.

Respectfully submitted,

Ivor R. Elrifi, Reg. No. 39,529
Shelby J. Walker, Reg. No. 45,192
Attorneys for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

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RESPONSE TO REQUIREMENT FOR RESTRICTION

In response to the March 22, 2001 Restriction Requirement in the above-identified application, Applicants provisionally elect the invention of Applicants elect Group 1, Claims 1-9, drawn to an isolated polynucleotide with polymorphic sequences, classified in class 536, subclass 23.1 with traverse.

Applicants request modification of the present restriction requirement under 37 C.F.R. §1.143. 35 U.S.C. §121 states: "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "**independent and distinct.**"

The MPEP §802.01 defines independent as follows:

The term "independent" (*i.e.*, not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

Furthermore, the subject matter of Groups IV and XIV can, in turn, be examined in a search of the subject matter of Groups I, II and III. Group IV is directed to isolated oligonucleotides with specific hybridization properties, while Group XIV is directed to oligonucleotide arrays. The oligonucleotide of Group IV (claims 41-44) hybridizes to a polymorphic sequence that includes a polynucleotide as recited in any of Groups I, II and III (claims 1-13). Thus, a search of the subject matter of Groups I, II and III encompasses the subject matter of Groups IV and XIV, and no undue burden is required to search Groups IV and XIV as well as Groups I, II and III.

Moreover, examination of both of these groups together might well reveal additional prior art pertinent to the either group. Thus, Applicants assert that: 1) the groups are not independent and distinct as required by the statute; and 2) it would not be a serious burden for the Examiner to examine the polynucleotides of Group II and III corresponding to the polynucleotides of Group I, or the oligonucleotides of Group IV and XIV corresponding to the polynucleotides of Groups I, II and III in light of the present disclosure.

Additionally, Applicants assert that Groups I, II, III, IV and XIV are **not** separate and distinct inventions. For example, in the May 19, 2000 Restriction Requirement (Paper 5) issued in USSN 09/442,349 (an application related to the present application, in which the structure and numbering of the originally filed claims are identical to those of the instant application), the Examiner retained claims 10-18 and 41-44 within Group I. Thus Group I included claims 1-9, **and** claims 10-11 (Group II in the present application), claims 12-13 (Group III in the present application), claims 14-18 (Group IV in the present application) **and** 41-44 (Group XIV in the present application), all of which are classified in class/subclass 536/23.1.

Applicants assert that Groups I, II, III, IV and XIV are not separate and distinct inventions. Accordingly, Applicants assert that Groups I, II, III, IV and XIV should be rejoined.

In light of the arguments above, Applicants respectfully request reconsideration and withdrawal of the present restriction requirement.

APPLICANTS: Shimkets and Leach
U.S.S.N.: 09/472,688

Election of Species of a Peptide

Applicants provisionally elect the following species **with traverse**: SEQ ID NO:509.

CONCLUSION

This amendment is due on or before July 22, 2001, with extension. A check in the amount of \$445.00 is enclosed to cover the petition fee for a three-month extension of time pursuant to 37 C.F.R. § 1.17(a)(3). Please charge any additional fees that may be due, or credit any overpayment, to Deposit Account No. 50-0311, Reference No.15966-534C CIP1 (CURA-34C CIP1).

Respectfully submitted,



Ivor R. Elrifi, Reg. No. 39,529
Shelby J. Walker, Reg. No. 45,192
Attorneys for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

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